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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/652,166	08/31/2000	Paul Chan H. Tse	NORT-0067 (12825RRUS01U)	2631

		EXAMINER
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ART UNIT	PAPER NUMBER
2645	

DATE MAILED: 03/29/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

	Application No.		Applicant(s)
Office Action Summary	09/652,166		TSE, PAUL CHAN H.
	Examiner		Art Unit
	Roland G. Foster		2645

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>06 January 2004</u>.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-32* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☒ Claim(s) *18* is/are allowed.

6)☒ Claim(s) *1-17 and 19-32* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage
application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
    Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____.

5)☐ Notice of Informal Patent Application (PTO-152)

6)☐ Other: _____.

DETAILED ACTION

Response to Arguments

Applicant's arguments with respect to claims 1-16 and 18-32 have been considered but are moot in view of the new ground(s) of rejection.

Applicant's arguments that U.S. Patent No. 6,212,506 B1 to Shah et al. was owned of subject to the obligation of Nortel were deemed persuasive. Therefore, any rejections using Shah as 103(c) prior art have been withdrawn. Not surprisingly however, the subject matter that the examiner relied in Shaw (e.g., "providing charge information for a toll call") is not patentable subject under the exclusive domain of Nortel. Accordingly, any claims previously rejected using Shah have again been rejected on new grounds.

Election/Restrictions

Applicant's amendment resulted in ten independent claims several of which claim differing features possibly corresponding to different embodiments disclosed in the applicant's specification (e.g., Figs. 1-7, see also pages 2 and 3 of the applicant's specification). In addition, the rejection below required differing combinations of prior art references to reject different groups of independent claims, which indicates that some administrative burden (e.g., separate status in the art) exists corresponding to each differing reference. However, in the interest of compact Office prosecution and because most limitations in the present subcombinations derive from previously set forth limitations, no holding of administrative burden for the purposes of claim restriction was set forth in this Office action. However, the applicant is notified that

further amendments, particularly amendments that introduce new limitations unique to each

group of independent claims, may establish sufficient administrative burden for the purposes of

restriction and accordingly trigger a restriction requirement.

Claim Rejections Using Wood as a Base Reference

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the

basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-4 and 13 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S.

Patent No. 6,091,808 to Wood et al. (hereinafter "Wood"), of record.

With respect to claim 1, see the following paragraphs for details on how Wood

anticipates particular limitations within the claim.

The limitation "displaying a hyperlink" reads on the browser display of Fig. 3 and col. 5,

lines 54 – 67.

The limitation "receiving an indication of user selection of the hyperlink" reads on Fig. 3

where the user makes a selection such as the dial button 75, which is a hyperlink (col. 5, lines 62-

67).

The limitation "generating a call request for establishing a call session over a packet-

based network based on the indication" reads on Wood as follows. The call request is generated

based on the indication (col. 7, lines 1-25). Wood discloses in an alternate embodiment that the

Internet (packet-based network) path 18 is the same path as telephone (voice communications)

path 14 (col. 3, lines 45-50). Therefore, the call is established over the Internet (a packet based

network).

The limitation "communicating voice data over the packet-based network in the call

session" reads on Wood as discussed above.

With respect to claim 2, see web browser 12.

With respect to claim 3, see Fig. 3.

With respect to claim 4, see col. 8, line 45 – col. 9, line 19.

With respect to claim 13, see Fig. 1.

Claim Rejections Using Nelson as a Base Reference

Claim Rejections - 35 USC § 102

Claims 1-3, 7, 13, 22, 24, 26, 27, 29, 30, 31, 33, 34, and 38 are rejected under 35

U.S.C. 102(e) as being anticipated by U.S. Patent NO. 6,628,644 B1 to Nelson et al. (hereinafter

"Nelson"), newly cited.

With respect to·claim 1, see the following paragraphs for details·on how Nelson

anticipates particular limitations within the claim.

The limitation "displaying a hyperlink" reads on Fig. 3, web page including speed dial

buttons 104, which is displayed through a web browser. The speed dial buttons 104 are a

selectable browser links to web server (IP phone) functionality (col. 7, lines 32-50 and col. 8,

lines 16-26). Since the web page is coded in hypertext markup language (html) (col. 5, lines 1-

30 and col. 6, lines 16-25), then the links are also hypertext links.

The limitation "receiving an indication of user selection of the hyperlink" reads col. 5,

lines 1-30 where selection of a hyperlink (e.g., the speed dial buttons 104) as discussed above

results in receiving a hypertext transfer protocol (http) request at the server (col. 5, lines 21-44).

The limitation "generating a call request for establishing a call session over a packet-

based network based on the indication" reads on Wood as follows. Selecting a speed dial button

104 generates the call request and the consequent reception of the http request as discussed

above. The call is established over Internet 40 (packet based network).

The limitation "communicating voice data over the packet-based network in the call

session" reads on the subsequent call.

Claim 7 differs substantively from claim 1 in that claim 7 recites an additional step

directed to displaying a hyperlink associated with a uniform resource locator. The speed dial

button 104 (displayable hyperlink) specifies (i.e., points to) a uniform resource locator (URL)

when selected (col. 5, lines 23-31). Thus, the display hyperlink is associated with a URL.

Claim 22 differs substantively from claim 1 in that claim 22 recites that the hyperlink is

associated with a URL containing the logical identifier of the callee where the logical identifier

is contained in the call request. Selecting the speed dial button 104 (hyperlink) results in

generating an associated URL as discussed above. The URL contains information that is used,

after parsing and domain name service (DNS) lookup (col. 5, lines 25-30), to request that the

web server (IP phone) set up a call to the telephone number of the called party (callee)

corresponding to the selected speed dial button. Therefore, the URL is a call request containing

the logical identifier of the callee (called party).

Claims 24 and 29 differ substantively from claim 1 in that they recite program

instructions and data signals embodied in a carrier wave that perform functions equivalent to the

steps of claim 1. The system is implemented as a computer based system (Fig. 1) and thus

executes program instructions in order to perform the various browsing and dialing functions.

The system is also implemented via the Internet (data signal embodied in a carrier wave) (Fig. 1).

Claims 24 and 29 also recite receiving a URL associated with the hyperlink and generating a call

request containing information in the URL.   See the claims 7 and 22 rejections above for details

regarding receiving a URL associated with the selected hyperlink.

Claim 30 differs substantively from claim 1 in that claim 30 recites a device comprising

components capable of performing functions equivalent to the steps of claim 1. Therefore, see

the claim 1 rejection for additional details. Further, the "display" reads on Fig. 3. The "storage

device" reads on the various web client computers (Fig. 1) capable of storing the html web pages

(and associated speed dial hyperlinks as discussed above) (col. 5, lines 1-31). A computer

inherently comprises a processor (controller) capable of executing stored programs (executable

routines) such as the web browser and HTML interpreter (col. 5, lines 1-15).

With respect to claims 2, 26, and 27, see Fig. 3 and the claim 1 rejection for additional

details. The speed dial hyperlink is associated with the telephone number of the called party.

With respect to claim 3, see the claim 1 rejection for further details.

With respect to claim 13, see Fig. 1.

With respect to claim 21, see Fig. 3 and the claims 7 and 22 rejections above.

With respect to claim 31, see Fig. 6, modify speed number 302, Fig. 7, and col. 9, lines 18-52.

With respect to claims 33 and 34, see Fig. 1, Internet 40.

With respect to claim 38, both signaling and voice data are exchanged via the Internet using an Internet protocol layer during a call session.

Claim Rejections - 35 USC § 103

Claims 4, 6, and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nelson as applied (if applicable) to claim 1, and further in view of U.S. Patent No. 6,310,873 B1 to Rainis et al. (Hereinafter "Rainis"), newly cited.

The subject claims differ substantively from claims 1, 7, and 22 in that they recite additional limitations directed to accessing rules information to determine further information (e.g., charge information) to add to the logical identifier of the called party and to provide charge information for a toll call.

Nelson discloses all within the claim (see the claim 1, 7, and 22 rejections for further details) except accessing rules information to determine further information (e.g., charge information for the toll call) to add to the logical identifier of the called party.

Rainis (similarly to Nelson) is directed to a system for establishing telephony calls over the Internet (abstract). Rainis also teaches that the client accesses rules information (basic payment model) to add additional information such as method of payment and charge information such as credit card number to the receiving party's telephone number (logical identifier) (col. 5, lines 1-15)

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to add to the logical identifier of the called party as disclosed by the Internet telephony system of Nelson additional information and charge information as taught by the Internet telephony system of Rainis.

The suggestion/motivation for doing so would have been to reduce the cost to operate an Internet telephony network by providing information that allows the Internet telephony provider to quickly and accurately charge back to the customer for the use of actual resources used during the call. Such billing would have been notoriously well known in the art of telephone systems. For example, calling card calls require the caller to add additional charge information (e.g., account number) when placing the call. In addition, the user-friendliness, efficiency, and flexibility of the Internet telephony system would have been because adding additional

information that allows the calling party to select desired method of payments such as electronic

cash, credit cards, or tokens (Rainis, col. 5, lines 1-8).

Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Nelson in view of

Rainis as applied to claims 1 and 4 above, and further in view of U.S. Patent No. 6,134,319 to

Burg et al. ("Burg"), as applied in the prior Office action.

Nelson as modified fails to teach determining if the call is local or long distance and

adding prefix information (special character) if the call is long distance.

However Burg (similarly to Nelson) teaches of system that remotely initiates a call via a

data network (Fig. 1) and that determines if the call is local/long distance adding a prefix number

if necessary (Fig. 4 and col. 5, lines 5-8)

Therefore, it would have been obvious to a person of ordinary skill in the art at the time

the invention was made to add local/long/prefix information as taught by the remote dialing

system of Burg to the remote dialing system of Nelson.

The suggestion/motivation for doing so would have been to increase user-friendliness,

efficiency, and accuracy but avoiding the "requirement for the caller to remember, or know,

these access codes when placing a call [] a drawback that can make placing an out-of-area phone

call burdensome" (Burg, col. 1, lines 13-54).

Claims 14, 20, 21, and 35-37 are rejected under 35 U.S.C. 103(a) as being unpatentable

over Nelson as applied to (if applicable) claims 24 , 29, and 30 above, and further in view of U.S.

Patent No. 6,553,515 B1 to Gross et al. (Hereinafter "Gross"), newly cited.

Claim 14 differs substantively from claim 1 in that claim 14 recites a device comprising

components capable of performing functions equivalent to the steps of claim 1. Therefore, see

the claim 1 rejection for additional details. Further, the "display" reads on Fig. 3. The "storage

device" reads on the various web client computers (Fig. 1) capable of storing the received html

web pages (col. 5, lines 1-31). A computer inherently comprises a processor (controller) capable

of executing stored program such as the web browser and HTML interpreter (col. 5, lines 1-15).

Claim 14 also recites that the call request comprises a session initiation protocol (SIP) message.

Nelson discloses all within the claim (see the claim 1 rejection for further details) except

that the call request comprises a SIP message.

Gross (similarly to Nelson) is directed to a system for establishing telephony calls over

the Internet (abstract). Gross also teaches that the SIP protocol is used to set up calls over the

Internet (col. 5, lines 5-26).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time

the invention was made to add the use of SIP protocol to set up a call over the Internet as taught

by the Internet telephony system of Gross to the Internet telephony system of Nelson.

The suggestion/motivation for doing so would have been to conform to Internet standards

where SIP is a standard protocol to initiate data sessions on the Internet (Gross, col. 5, lines 6-7).

In addition, the flexibility and versatility of call setup would have been increased because SIP

provides enhanced services such as call forwarding and also handles other address formats such

as H.323 telephone numbers (Gross, col. 5, lines 6-26).

With respect to claim 20, see Fig. 3 and the claim 1 rejection.

With respect to claim 22, see Fig. 3 and the claim 7 and 22 rejections above.

With respect to claims 35-37, see the claim 14 rejection for further details.

Claims 15-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nelson in

view of Gross as applied to claim 14 above, and further in view of Burg. The teaching of Burg

would have been an obvious addition to Nelson in view of Gross for the same reasons as set forth

in the claim 5 rejection above. The resulting modification would have resulted in a storage

device containing call rules to determine whether the call is local or long distance and adding

special characters (e.g., prefix numbers) if necessary.

Claims 8-12, 23, 25, and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable

over Nelson as applied to claims 1, 7, 22, and 24 above, and further in view of U.S. Patent No.

6,453,034 to Donovan et al. (hereinafter "Donovan"), of record.

Although Nelson discloses a URL that identifies a telephone number, Nelson fails to

disclose that the URL actually contains both a telephone number and a protocol identifier that

identifies the URL as telephony related where the URL is copied into another storage.

However Donovan (similarly to Nelson) teaches of an Internet telephony system

(abstract) where the URL includes a telephone number and protocol identifier (SIP) that

identifies the URL as telephony related (col. 3, lines 45-60). The URL is also copied into

another storage as it is transported across the IP network in order to initiate a real time protocol

(RTP) sessions. Id.

Therefore, it would have been obvious to a person of ordinary skill in the art at the time

the invention was made to add a telephone number and protocol identifier that identifies the URL

as telephony related where the URL is copied as taught by the Internet telephony of Donovan to

the Internet telephony system of Nelson.

The suggestion/motivation for doing so would have been to conform to Internet standards

where SIP is a standard protocol to initiate data sessions on the Internet. In addition, the

flexibility and versatility of call setup would have been increased because SIP provides enhanced

services such as call forwarding and also handles other address formats such as H.323 telephone

numbers.

Claim 32 is rejected under 35 U.S.C. 103(a) as being unpatentable over Nelson as applied

to claim 30 above.

Although Nelson teaches that the system provides an e-mail routine (col. 7, lines 40-45),

Nelson fails to specifically disclose that the e-mail system adds the hyperlink to e-mail.

However, "Official Notice" is taken that both the concepts and advantages of an e-mail

system able to add hyperlinks to e-mail messages would have been well known and expected in

the art.

Therefore, it would have been obvious to a person of ordinary skill in the art at the time

the invention was made to add an e-mail routine capable of adding hyperlinks to e-mail to the e-

mail routine disclosed by Nelson.

The suggestion/motivation for doing so would have been to conform to e-mail standards,

which support the inclusion of hyperlinks within e-mail messages. In addition, user-friendliness,

versatility, and efficiency would have been increased by allowing an e-mail recipient the ability

to directly access a desired website by clicking on any URL included in a received message, as is

notoriously well known in the art.

Allowable Subject Matter

Claim 18 is allowed.

Examiner's Reasons For Allowance

Claim 18 is directed to a detailed device capable of participating in call sessions over a

data network. A controller generates a call request in response to selection of a hyperlink and

then accesses call rules to determine how the call request is to be generated. The controller adds

one or more special characters to provide a function based on call rules wherein the function is

selected from the group consisting of disabling call waiting, inserting a pause, and navigating an

automated attendant.

The closest prior art of record is Nelson and Wood as discussed above. However, both

fail to disclose the closed group of controller functions as recited by the applicant.

The remaining prior art of record fails to teach or fairly suggest the obviousness of

modifying Nelson or Wood in order to support the closed group of controller functions recited by

the applicant.

The above reasons for allowance are based on the claims as presently set forth in their totality. The above reasons for allowance should not be interpreted as indicating that amended claims broadly reciting certain limitations discussed in the above reasons for allowance would be allowable. A more detailed reasons for allowance may be set forth in a subsequent Notice of Allowance if and when all claims in the application are put into a condition for allowance.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Roland Foster whose telephone number is (703) 305-1491. The examiner can normally be reached on Monday through Friday from 9:00 a.m. to 5:30 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fan S. Tsang, can be reached on (703) 305-4895. The fax phone number for this group is (703) 872-9309.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to customer service whose telephone number is

(703) 306-0377.

3/22/04

Roland G. Foster
Primary Patent Examiner